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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/639,879	08/17/2000	Toshiyuki Shibuya	A243-1	5305
21254	7590	02/25/2004	EXAMINER	
MCGINN & GIBB, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			KISS, ERIC B	
			ART UNIT	PAPER NUMBER
			2122	12

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/639,879

Applicant(s)

SHIBUYA, TOSHIYUKI

Examiner

Eric B. Kiss

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date Z.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The reply filed December 15, 2003 (hereinafter *Paper No. 11*), correcting the deficiencies of the reply filed August 28, 2003, has been received and entered. Accordingly, the reply filed August 28, 2003 (hereinafter *Paper No. 8*), has also been entered. Claims 1-5 and 7-34 are pending.

Priority

2. Applicant's statements in *Paper No. 8*, on p. 16, along with the submitted photocopy of the receipt postcard, which indicates that a certified copy of the priority document was filed on August 17, 2000, are considered sufficient evidence that Applicant has complied with the requirements of 35 U.S.C. §119(b). Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on August 17, 1999.

Response to Amendment

3. The amendment filed August 28, 2003 (*Paper No. 8*), is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The Replacement Sheet for Figure 5 changes

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the flow of the disclosed steps upon the completion of steps S408 and S409. As is disclosed in the specification,

If there is such a request (YES in step S407), the programs stored in the first memory are changed in step S408. **Then steps 406 and 407 are carried out again.**

If there is not such a request (NO in step S407), it is judged in step S409 whether there is a request to turn off the portable terminal device 1.

If there is not such a request (NO in step S409), **steps 406, 407, and 409 are carried out again.** [emphasis added; see p. 13, line 29, through p. 14, line 6].

Although Applicant contends that the Replacement Sheet corrects a previous error (see p. 10 of the reply filed August 28, 2003), it is noted that the originally filed version of Fig. 5 appeared to be consistent with the original specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. Applicant's amendment to claim 32 appropriately addresses the rejection of claim 32 under 35 U.S.C. §112, second paragraph, as detailed in the previous office action. Accordingly, this rejection is withdrawn in view of Applicant's amendment.

Response to Arguments

5. Applicant's arguments filed August 28, 2003, have been fully considered but they are not persuasive.

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a. Applicant's arguments (*In Paper No. 8*) on p. 14, in paragraph 5, fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

b. In response to Applicant's arguments (*in Paper No. 8*) on p. 14, in paragraph 6, continuing onto p. 15, the Examiner asserts that Cowan discloses at least two existing programs (or a plurality of programs) stored in the terminal being characterized as to-be-used or to-be-removed programs by the terminal device. For example, when an upgrade is performed in fail-safe mode (as disclosed in col. 12, lines 49-59), the files belonging to the new version are downloaded. During this operation, both the new files (to-be-used) and the old files (to-be-deleted) are stored in the memory. Upon successful completion of the download, the old files are discarded (deleted).

c. In response to Applicant's arguments (*in Paper No. 8*) on p. 15, in paragraph 4, see the response above in item 5b.

d. In response to Applicant's arguments (*in Paper No. 8*) on p. 15, in paragraph 8, this argument is moot in view of the new ground of rejection presented below.

e. In response to Applicant's arguments (*in Paper No. 11*) on p. 3, in paragraph 4, see the response above in item 5a.

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f. In response to Applicant's arguments (*in Paper No. 11*) on p. 3, in paragraphs 5-6, see the response above in item 5b.

g. In response to Applicant's arguments (*in Paper No. 11*) on p. 4, in paragraphs 3-4, the Examiner asserts that the version identifiers of Cowan are indicia about the programs in the first and second memories. See the rejection of claim 34 below for more detail.

Claim Objections

6. Claim 34 is objected to because of the following informalities: "andsaz" in line 9 should apparently read --and--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1, 2, 4, 5, 7, 8, 10-18, 20-28, and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,848,064 to Cowan.

As per claims 1, 4, and 32, Cowan discloses a portable terminal device (mobile terminal) comprising a memory storing therein at least two programs (or a plurality of programs) being characterized as to-be-used or to-be-removed programs by the terminal device (see, for example, col. 1, lines 48-57; col. 7, lines 13-31; and col. 12, lines 49-59). Cowan further disclose a management table which stores first data about whether each of said programs is used or not (see column 7, lines 37-50; and column 12, lines 49-52), and removes a non-used program from said memory (see, for example, column 12, lines 49-55). For example, when an upgrade is performed in fail-safe mode, the files belonging to the new version are downloaded. During this operation, both the new files (to-be-used) and the old files (to-be-deleted) are stored in the memory. Upon successful completion of the download, the old files are discarded (deleted).

As per claim 2, Cowan further discloses the memory adding only a necessary program from a program-transferring device, in accordance with said data, wherein said necessary program comprises said to-be-used program (see column 13, lines 15-46).

As per claims 5 and 14, Cowan discloses a portable terminal device (mobile terminal) comprising memory storing at least one program transferred from a base station (see, for example, Fig. 1; and col. 11, line 66, through col. 2, line 19), memory storing therein a main program and an application program (see column 7, lines 13-36) and data about the main and application programs in the form of a table (see, for example, column 8, lines 19-32; and column 12, lines 15-28); a signal receiving/transmitting circuit and a central processing unit (see Fig. 2).

As per claims 7 and 27 (see the rejection of parent claim 22 below), Cowan further discloses package definition files including a program ID of each program (file name), a flag indicating whether each program is used or not (a user selection); a packet number and final

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packet number transferred from the program-transferring device (see, for example, column 13, lines 54-65); an initial address (mobile terminal path and host path); and a program length (memory required; see Figs. 5a through 5d; column 11, lines 24-35; and column 14, line 62 through column 15, line 9).

As per claim 8, see the disclosure applied above to claim 2.

As per claims 10-12, Cowan further discloses the memory comprising an EEPROM portion (see column 7, lines 15-19) and a RAM portion (see column 9, lines 12-15).

As per claim 13, the connection of a power source to the RAM in Cowan is implied as files are transferred to and stored in the RAM (see column 9, lines 12-15).

As per claims 15 and 22, in addition to the disclosure applied above to claims 1 and 5, Cowan further discloses a base station and a program-transferring device (host; see Fig. 1).

As per claims 16, 21, 23, 28, and 31, see the disclosure applied above to claims 2 and 4.

As per claim 26, Cowan further discloses storing data about whether the main program and application program is used or not (see, for example, column 8, lines 19-32; column 12, lines 15-28; and column 14, lines 50-61).

As per claims 17, 18, 24, and 25, Cowan uses an IP address associated with each mobile terminal to encode transmissions (see, for example, column 8, lines 25-32).

As per claims 20 and 30, Cowan further discloses the program-transferring device comprising a memory storing a program, a encoding/transferring circuit, and a controller circuit (see Fig. 3).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, 9, 19, 29, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,848,064 to Cowan in view of U.S. Patent No. 5,842,216 to Anderson et al.

As per claim 3, in addition to the disclosure applied above to claim 1, Cowan further discloses a first device to carry out a program, said first device causing said memory to boot a used program to said first device with reference to said first data, if version information of said memory is not coincident with a check sum of said first device, and copying programs stored in said first device into said memory (see Fig. 8(b); and column 12, lines 60 through column 13 line 46; the mobile terminal, as part of a boot-up process has its stored version information compared with that stored in the host computer, and updates are performed if necessary). Cowan fails to expressly disclose the version information comprising a checksum. However, Anderson et al. teach the use of a checksum as an advantageous alternative to simple version information, for determining if a data transfer is necessary (see, for example, col. 3, lines 54-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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modify the invention of Cowan to include the use of a checksum in place of, or in addition to, the version information for comparing software data. One would be motivated to do so to increase the reliability of such metadata.

As per claims 9, 19 and 29, see the disclosure and teaching applied above to claim 3. For reasons stated above, such claims also would have been obvious.

As per claim 33, see the disclosure and teaching applied above to claims 3 and 5. For reasons stated above, such a claim also would have been obvious.

11. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,848,064 to Cowan in view of U.S. Patent No. 5,414,751 to Yamada.

As per claim 34, Cowan discloses storing first indicia of said existing and used programs in a table of a memory of said terminal device (see column 7, lines 37-50; and column 12, lines 49-52); requesting a change of programs by said terminal device, said change of programs including at least one of an added program and a deleted existing program (see column 7, lines 37-50; and column 12, lines 49-52); and storing said second indicia of said change of programs in said table (see column 7, lines 37-50; and column 12, lines 49-52). Cowan further discloses loading an added program into memory (see, for example, col. 12, lines 29-59); using (booting) an updated version of software while deleting (non booting) an unused, older, version of the software (see, for example, col. 12, lines 49-52). Cowan fails to expressly disclose copying existing and used programs from a second memory to a first memory of said terminal device prior to performing the upgrading. However, Yamada teaches copying existing and used

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programs from a second memory to a first memory of a terminal device and loading an added program into the first memory as part of a software upgrading process (see, for example, col. 4, lines 20-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Cowan to include such copying during upgrading as per the teachings of Yamada. One would be motivated to do so to increase the reliability of the upgrade process.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric B. Kiss whose telephone number is (703) 305-7737. The Examiner can normally be reached on Tue. - Fri., 7:30 am - 5:00 pm. The Examiner can also be reached on alternate Mondays.


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam, can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EBK /EBK

February 19, 2004



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SUPERVISORY PATENT EXAMINER